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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91161817
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

NEXTEL COMMUNICATIONS, INC.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opp. No.: 91/161,817
	)	App. No.: 78/235,618
	)	Pot. Mark: SENSORY MARK
MOTOROLA, INC.,	)	(911 Hz Tone)
	)	
Applicant.	)	

**OPPOSER'S REPLY TO APPLICANT'S  
OPPOSITION TO OPPOSER'S  
MOTION FOR SUMMARY JUDGMENT**

January 9, 2006

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**I. Introduction**

In its Opposition to Nextel's Summary Judgment Motion ("Opp."), Applicant Motorola goes to great lengths to refute arguments that Nextel never made, and fails entirely to provide any facts or law that would contradict those it did make. Motorola cannot avoid the conclusion that, as a matter of law and undisputed fact, the 911 Hz Tone is not entitled to registration as a trademark.

Nextel's argument is not that the 911 Hz Tone could not be used as a mark. It is instead that the tone has not been used as a mark. Opposer's Motion for Summary Judgment and for Suspension of Proceedings ("Nextel SJM") at 2, 10, 12, 13-16. All of the cases cited by Motorola in its Opposition, from the Board to the Supreme Court, acknowledge the fundamental rule that, whether for a non-traditional mark or a dual purpose mark or any other kind of mark, the applicant must show that the subject matter of its application "meets the basic trademark requirements" before registration can issue. *See, e.g., Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 166, 174, [34 U.S.P.Q.2d (BNA) 1161, 1164, 1167] (1995). Here, based on the undisputed evidence, those basic trademark requirements have not been met.

**II. Argument**

**A. Motorola's Legal Arguments Miss the Point.**

Contrary to Motorola's assertions, Nextel's Summary Judgment Motion does not present issues of first impression, even though the application is for registration of a sound mark. The straightforward issue is whether that sound was used as a trademark. The remarkably parallel

statements of fact set out in the parties' respective summary judgment motions compel the straightforward conclusion, as a matter of law, that it was not.

Motorola criticizes Nextel for having failed to cite *Qualitex*. Opp. at 1. But the Supreme Court's explicit holding in that case directly supports Nextel's argument here:

We conclude that, sometimes, a color will meet ordinary legal trademark requirements. And, when it does, no special legal rule prevents color alone from serving as a trademark.

514 U.S. at 160-161, [34 U.S.P.Q.2d (BNA) at 1162] (emphasis added). The Court characterized the requirement that a mark must be used to distinguish goods from those manufactured by others and to indicate source as the "more important part" of the statutory prerequisites for registration. *Id.* at 162 [34 U.S.P.Q.2d (BNA) at 1162]. And the Court expressly based its reversal of the Ninth Circuit's ruling on the fact that the District Court had entered undisputed findings that the color had met the basic trademark requirement of having been used as a source-indicating mark. *Id.* at 166, 174 [34 U.S.P.Q.2d (BNA) at 1164, 1167].

Motorola also asserts that Nextel's motion is flawed because it fails to recognize case law permitting the registration of "dual purpose" marks. Opp. at 5-7. But the 911 Hz Tone has not been used for dual purposes. Instead, it has consistently been used for a single operational purpose, and not as a trademark.<sup>1</sup> Each "dual purpose" case cited by Motorola makes clear that use as a source-identifying trademark is a prerequisite to registration.<sup>2</sup> Under the undisputed

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<sup>1</sup> The sound mark registrations listed by Motorola, Opp. at 8, might be valid "dual purpose" marks, but they nonetheless could provide no support for registration of the 911 Hz Tone, for which the undisputed evidence shows that it has not been used as a trademark. *See also* TMEP § 1207.01(d)(vi) ("Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the agency or the Board."); *In re Sunmarks Inc.*, 32 U.S.P.Q.2d (BNA) 1470, 1472 (TTAB 1994).

<sup>2</sup> *In re Paramount Pictures*, 217 U.S.P.Q. (BNA) 292, 293-94 (TTAB 1983) ("it is clear

facts here, the 911 Hz Tone has consistently and exclusively been used in its function as an operational alert signal,<sup>3</sup> in a way that would not be perceived by consumers or purchasers as a source-indicating trademark.

Motorola also misconceives Nextel's argument about the fact that Motorola has failed to present evidence that it "highlighted" or emphasized the 911 Hz Tone, through advertising or otherwise. *See* Opp. at 10. The relevance of such evidence, if it actually existed, would be to the question of whether the tone was used in a way that would be perceived as a mark. So, for example, the *Benetton* and *Upper Deck* cases cited in Nextel's motion reviewed advertising materials as part of this necessary evidentiary analysis, even though the subjects of those cases were goods, not services. The undisputed facts here show that the 911 Hz Tone was never used in a way that created an independent commercial impression for that single alert signal (among the many tones emitted by Motorola's two-way radios) such that it would be perceived as a source identifier.

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that [STAR TREK] performs a trademark function" when used on towels, sheets, etc., as when used on other goods for which registrations had issued); *In re Watkins Glen Int'l, Inc.*, 227 U.S.P.Q. (BNA) 727, 728-29 (TTAB 1985) (stylized checkered flag, which was the non-disclaimed portion of a previously registered mark, "engenders a commercial impression by itself," and is an "indicia of source" that may be registered); *In re Paramount Pictures*, 213 U.S.P.Q. (BNA) 1111, 1113-14 (TTAB 1982) (MORK & MINDY on decals likely to be perceived by purchasers as source indicator). Indeed, in the earlier *Paramount* case, the Board cites the same *Whataburger* decision cited by Nextel in its motion in discussing the standard for determining whether an ornamental feature is used in such a way that it will be perceived as functioning as an indicator of the good's source, 213 U.S.P.Q. (BNA) at 1113, and expressly acknowledges that registration of an alleged dual use mark should be refused "where it [is] not apparent that the subject matter sought to be registered would be perceived as a mark." *Id.* at 1114 n.8.

<sup>3</sup> Despite its occasional statements that the 911 Hz Tone "functions" as an alert signal, Nextel does not argue that registration of the Tone should be barred under the "functionality" doctrine, and Motorola's arguments regarding that doctrine, Opp. at 8-9, are irrelevant.

**B. Motorola Provides No Evidence That the 911 Hz Tone Has Been Used as a Mark.**

Motorola's opposition brief saves until last an argument headed "The Sound Mark is Registrable if it Performs a Source-Identifying Function." Opp. at 20. While that heading correctly states the legal requirement, however, the argument that follows does not provide any factual support for the 911 Hz Tone's having met that requirement. Instead, it only attempts to distinguish the cases that have articulated and applied the standard used to determine whether a designation has in fact been used as a mark. Opp. at 20-21. This attempt fails.<sup>4</sup>

As the court stated in the *Microstrategy* decision partially quoted by Motorola, a designation cannot be held to have been used as a mark unless it is consistently presented in a way "that makes 'its nature and function readily apparent and recognizable without extended analysis.'" *Microstrategy Inc. v. Motorola, Inc.*, 245 F.3d 335, 342, [58 U.S.P.Q.2d (BNA) 1278, 1282] (4<sup>th</sup> Cir. 2001). But the "function" the court referred to was its function as a trademark. Motorola follows this quote with its only factual argument -- an assertion that "[i]n contrast" to its litigation opponent in the *Microstrategy* case (where it was taking the other side of this same argument), Motorola has made efforts to present the 911 Hz Tone "in a consistent manner," and it has "taught consumers to recognize" the Tone. Opp. at 21. But even the deposition testimony cited in support of this assertion makes clear that it is the Tone's operational function, not any trademark function, that is what Motorola has taught consumers to

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<sup>4</sup> Among other reasons, Motorola's suggestion that the cases are inapplicable because they "are merely cases dealing with deficient specimens of use," Opp. at 20, is flatly wrong. The specimens were viewed in those cases as evidence of how the alleged mark was being used. The ground of decision in those cases was that the actual use of the alleged marks, demonstrated by the specimens, did not meet the statutory requirement of use as marks. *See, e.g., In re Moody's Investors Serv., Inc.*, 13 U.S.P.Q.2d (BNA) 2043, 2045-48 (TTAB 1989)(considering all evidence of record regarding nature of use of mark). The same conclusion applies here.

recognize. The testimony was that the 911 Hz Tone was consistently used to assure that “the operation overall of the products in the customers’ hands when they used operations involving the tone matched previous products,” pursuant to an internal Motorola directive that “[t]he new product that’s replacing the old product must match functionality.” Opp. at Ex. 1, Klein Dep. at 13-14.<sup>5</sup> The undisputed facts demonstrate that the “nature and function” of the 911 Hz Tone is as an alert signal, and it cannot be registered as a trademark.

**C. Motorola’s Distinctiveness Arguments Cannot Cure this Fatal Defect.**

Because the 911 Hz Tone has not been used as a mark, evidence regarding distinctiveness cannot support a registration. Again, Motorola attempts to distinguish each of the cases Nextel has cited based on their particular facts. *See* Opp. at 19-20. But again, the legal principle applied by those cases applies equally to the facts here. If a designation does not function as, and has not been used as, a source-indicating trademark, it cannot be registered notwithstanding evidence of distinctiveness. *See* TMEP 1212.02(i); *see also, e.g., In re Mancino*, 219 U.S.P.Q. (BNA) 1047, 1048 (TTAB 1983) (“Since the refusal . . . was based on applicant’s failure to demonstrate technical service mark use, the claim of distinctiveness under Section 2(f) was of no relevance”); *In re Wakefern Food Corp.*, 222 U.S.P.Q. (BNA) 76, 78-79 (TTAB 1984) (finding that a phrase “would not be perceived by the public” as a source-identifying mark and was thus unregistrable, and that evidence of distinctiveness was therefore irrelevant, even though that

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<sup>5</sup> Mr. Klein also baldly asserted that the tone “represents two things” in the product, which were that the “audio path is open and the mike is available” [i.e., the alert signal] and that “it refers to Motorola products.” Opp. at Ex. 1, Klein Dep. at 28. But he later explained that the knowledge that the tone is from Motorola products is based on users’ exposure to the tone in training and other non-trademark uses, and to the Motorola trademarks that are embossed on the radios themselves. *Id.* at 45-46.

evidence supported a finding that the phrase was associated with the applicant, and was not merely descriptive).<sup>6</sup>

**1. The Sound is Not Inherently Distinctive.**

Motorola asserts, without support, that the 911 Hz Tone is by its very nature “unique, different, and distinctive.” Opp. at 12. But the question of inherent distinctiveness must be approached from the perspective of a mark’s ability to distinguish goods from those manufactured by others and to indicate source. See *In re Soccer Sport Supply Co., Inc.*, 507 F.2d 1400, 1402, [184 U.S.P.Q. (BNA) 345, 347] (CCPA 1975) (design may be inherently distinctive if it is “arbitrary and distinctive and if its principal function is to identify and distinguish the source of the goods”) (emphasis added); *In re Raytheon Co.*, 202 U.S.P.Q. (BNA) 317, 318 (TTAB 1979) (design may be inherently distinctive if it can itself “create a commercial impression as an indication of origin”). In the context of the trade dress and “dual use” ornamentation issues, which Motorola itself has raised, the Board and the courts have refused to find a design inherently distinctive, even if it is indisputably unique in terms of not being identical to any design used by others, if it represents a “mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the

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<sup>6</sup> In *In re Owens-Corning Fiberglas Corp.*, 221 U.S.P.Q. (BNA) 1195 (TTAB 1984), where the Board determined that the applicant’s pink color for fiberglass insulation did not function as a trademark, it had considered evidence submitted by the applicant under Section 2(f) as also relevant to the question of whether the color functioned as a mark. *Id.* at 1198 & n.3. On review of that same evidence, the Federal Circuit reversed the Board’s finding that the color did not function as a trademark, and permitted registration under Section 2(f). *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 U.S.P.Q. (BNA) 417, 425 (Fed. Cir. 1985). Although the Board’s approach was not disputed by the applicant on appeal, the court treated the question before it as whether the color was registrable under Section 2(f). *Id.* at 422. Unlike the case here, however, the evidence established that (1) the applicant’s use of the color “perform[ed] no non-trademark function,” (2) applicant had engaged in extensive advertising and promotion that specifically emphasized the color, and (3) 50% of respondents in a valid consumer survey identified the applicant as the manufacturer of pink insulation. *Id.* at 421, 423-24.



public as a dress or ornamentation for the goods.” *See In re Hudson News Co.*, 39 U.S.P.Q.2d (BNA) 1915, 1922 (TTAB 1996) (*quoting Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 U.S.P.Q. (BNA) 289, 291 (CCPA 1977)); *In re Kinderman & Sons, Inc.*, 46 U.S.P.Q.2d (BNA) 1253, 1255 (TTAB 1998); *In re The General Tire & Rubber Co.*, 160 U.S.P.Q. (BNA) 415, 416-17 (CCPA 1969) (typical purchaser would view alleged mark as just a refinement of a widely used ornamentation “concept” rather than as a trademark).

Here, the undisputed evidence provided by Motorola’s witness is that manufacturers of two-way radios must provide alert indications to notify users of the activation of specific radio functions. *See* Nextel SJM, at Ex. 4, Klein Dep. at 92, 93-95. Moreover, the particular electronic tone at issue in this proceeding, like all the other signal tones emitted by Motorola’s radios, was selected from among a set of choices that was strictly limited by the technical constraints of the radio’s signal generator. *Id.* at 58-60. As in the *CITC Industries* and *Anchor Hocking Glass Corporation* cases discussed in Nextel’s opening brief, and as in the trade dress and ornamentation cases cited above, the 911 Hz Tone would be perceived by consumers as “just a refinement” of the electronic signal tones generally emitted by all two-way radios, and not an indication of the particular radio’s source. Thus, it cannot be found inherently distinctive.<sup>7</sup>

## **2. The Sound Has Not Acquired Distinctiveness.**

Even if such evidence were relevant here, the undisputed evidence fails to support Motorola’s assertion that the 911 Hz Tone has acquired distinctiveness. As a matter of law, Motorola’s assertions that it has expended hundreds of thousands of dollars on advertising and

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<sup>7</sup> Indeed, the Supreme Court has held that a product design, which may be more analogous than product ornamentation to the alert tone at issue here, can never be inherently distinctive. *Wal-Mart Stores, inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212-214 (2000).

promoting its two-way radio products, Opp. at 13, cannot support a finding of acquired distinctiveness, because those expenditures did not entail any use of the 911 Hz Tone as a trademark. *See In re Redken Labs., Inc.*, 170 U.S.P.Q. (BNA) 526, 529 (TTAB 1971); *In re E.I. Kane, Inc.*, 221 U.S.P.Q. (BNA) 1203, 1206 (TTAB 1984); *cf. In re American Home Prod. Corp.*, 226 U.S.P.Q. (BNA) 327, 330 (TTAB 1985) (overall product advertising expenditure evidence sufficient where advertising materials “clearly and unambiguously promote trademark recognition of applicant’s [ornamental design]”) . Motorola has not included the 911 Hz Tone in any advertising, and the tone is presented at trade shows and in other contexts specifically and exclusively in its role as an operational alert signal.

Also as a matter of law, Motorola’s survey evidence cannot support a finding of acquired distinctiveness, for at least two reasons.<sup>8</sup> First, as discussed in Nextel’s motion, Motorola’s survey simply asked the wrong question. *Cf. In re E.I. Kane, Inc.*, 221 U.S.P.Q. (BNA) 1203, 1206 (TTAB 1984). The results do not reflect any association of the alleged 911 Hz Tone mark with any particular manufacturer. The ultimate question was explicitly limited to knowledge about the manufacturer of a particular radio device that had been identified in an intervening question, and thus provides no evidence about the potential acquired distinctiveness of the alleged mark itself. *See, e.g., Boston Beer Co. v. Slesar Bros. Brewing Co.*, 9 F.3d 175, 179 [28 U.S.P.Q.2d 1778, 1780-81] (1<sup>st</sup> Cir. 1993) (ultimate question asked in such a way that results reflected association “between product and place [*i.e.*, Boston], but not between product and

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<sup>8</sup> Should the Board decline to grant Nextel’s summary judgment motion, Nextel intends to challenge a number of other deficiencies in the survey, including sample selection, questionnaire bias, and coding of results. For summary judgment purposes, however, the survey fails as a matter of law, even taking it at face value.

source”) The Motorola survey results, on their face, simply do not provide results that can be used to support any acquired distinctiveness of the 911 Hz Tone.

Second, the survey results, even if valid, would show that only 14% of responses identified Motorola, and that percentage is simply too small to establish acquired distinctiveness. *See, e.g.,* Rudolf Callman, *Unfair Competition Trademark and Monopolies*, § 20:30 at 354-351 (4<sup>th</sup> ed. 2005). Motorola asserts that its survey result was 42% rather than only 14%, by adding the 29% of respondents who identified Nextel, not Motorola. *See* Opp. at 16-17. But Motorola’s reliance on the *Tone Brothers* decision and the “anonymous source rule” to seek credit for these Nextel responses, Opp. at 17-18, is flatly wrong in this context. The *Tone Brothers* court made quite clear that the anonymous source rule “is directed to the situation where a typical buyer would not know the corporate identity of the source.” *Tone Bros. Inc. v. Sysco Corp.*, 28 F.3d 1192, [31 U.S.P.Q.2d 1321, 1329] (Fed. Cir. 1994). That is not the situation here. The federal court cases cited by Nextel, which Motorola asserts to be “contrary” to *Tone Brothers* or actually to have been wrongly decided, Opp. at 18, are in fact entirely consistent with the express holding of *Tone Brothers*.

The *Lund* decision, for example, explicitly acknowledged that the “‘anonymous source’ rule protects companies with a valid trademark in cases where the public may not know the [owner] by name.” *I.P. Lund Trading ApS v. Kohler Co.*, 118 F. Supp.2d 92, 107, [56 U.S.P.Q.2d (BNA) 1776, 1788] (D. Mass. 2000). But in that particular case, where the survey respondents were knowledgeable salespeople and the competing products were distributed under the names of their respective sources, yet nearly half of respondents identifying the product with a single source identified one of plaintiff’s competitors as its source, the court found the evidence insufficient to permit the plaintiff to assert exclusive rights in the alleged design mark against

that defendant. *Id.* at 107, [56 U.S.P.Q.2d (BNA) at 1789]. Here, Motorola asserts that users associate the tone with a Motorola product, based on “the obvious: users of the product see the MOTOROLA trademark and design trademark when they handle the two-way radio.” Opp. at 7. Under these circumstances, the “anonymous source” rule is inapplicable here.

Indeed, the very commentator that Motorola cites in support of its erroneous argument actually criticizes Dr. Rappeport’s study in *Lund*, for the much same reasons Nextel criticizes his study here:

. . . one of the plaintiff’s two surveys in Lund III seems ill-conceived. According to the Lund III district court, when respondents were shown plaintiff’s faucet (among others) and were asked who made it, twenty percent said plaintiff, eighteen percent said defendant, ten percent said some other manufacturer and thirteen percent said one source they could not name. Somewhat remarkably, plaintiff argued that this established secondary meaning because it showed that a majority of respondents (sixty-one percent) believed that the faucet originated from a single source. . . . plaintiff inexplicably relied on answers which showed that relatively few respondents (twenty percent) believed the faucet came from plaintiff and that a majority of respondents (sixty-one percent) identified a number of different companies as the product’s source.

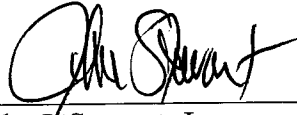
Vincent N. Palladino, *Secondary Meaning Surveys in Light of Lund*, 91 Trademark Rep. 573, 616 (2001). Motorola’s use of Dr. Rappeport’s study results here is equally inexplicable.

### **III. Conclusion**

For the reasons stated herein, Nextel respectfully requests that the Board GRANT its Motion for Summary Judgment, sustain Nextel’s Opposition, and refuse registration of the 911 Hz Tone.

January 9, 2006

Respectfully submitted,



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**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of OPPOSER'S OPPOSITION TO  
APPLICANT'S MOTION FOR SUMMARY JUDGMENT was served on counsel for  
Motorola on the 9<sup>th</sup> day of January, 2006, by e-mail and by first class mail to:

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